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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,448	11/20/2000	Dale F. McIntyre	81884F-P	1988

1333 7590 02/12/2004

PATENT LEGAL STAFF  
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ROCHESTER, NY 14650-2201

EXAMINER
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RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/717,448

Applicant(s)

MCINTYRE ET AL.

Examiner

Rob Rhode

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-28-2004 has been entered.

### ***Response to Amendment***

Applicant amendment of 1-28-04 amended claims 1, 8 and 9 as well as added claim 16. The applicant also traversed rejections of Claims 1 - 15.

Currently, claims 1- 16 are pending.

### ***Claim Objections***

Claim 8 is objected to because of the following informalities: The word(s) delineating each step of a method claim needs to begin with a verb. For example, the applicant begins several steps with the word "said". Instead, these steps should begin with a verb - such as "forwarded said identifying data" to clearly delineate the beginning of a new action step.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is: forwarding of the image with identifying data that identifies that digital images are forwarded to a third party for ordering of goods and/or services made using photosensitive media. While the applicant has this phrase in as part of the first step in the method, it should be a separate step.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre (US 6,104,885) in view of Enomoto (US 5,974,401) and further in view of Garfinkle (US 6,133,985).**

Regarding claims 1, 8 and 9 (currently amended), the combination of McIntyre, Enomoto and Garfinkle teach a method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising; where McIntyre teaches substantially simultaneously capturing an image

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both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media (see at least Abstract). Please note that little patentable weight is given to the phrase "that identifies that the digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photo sensitive media" since such recitation is not an active step.

However, McIntyre does not specifically disclose and teach a method of said identifying data being forwarded to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media.

On the other hand, Enomoto teaches a method of said identifying data being forwarded to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media (see at least Abstract, Col 2, lines 40 – 43 and Figures 1 and 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of McIntyre with the method of Enomoto to have enabled said identifying data being forwarded to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media. In

this manner, the customer can transmit information (i.e. in various forms) that identifies the images with specific data in order to fully identify the images for the potential printing of higher quality images. In this manner, the customer can provided the identifying data for the images, which will provide clear designation of the images as well as providing an opportunity to obtain a quote regarding the cost of developing these photos – if desired. Moreover, the customer's satisfaction will be increased at having the ability to identify specific images as well as having a quote provided associated with developing specific photos.

The combination of McIntyre and Enomoto teach key limitations of the applicant's invention.

However, the combination does not specifically disclose and teach a method of transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted; and said third party placing an order for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed.

On the other hand, Garfinkle teaches a method of transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted (see at least Col 8, lines 14 – 25); and said third party placing an order for goods and/or services with respect to said images on said photosensitive media using said identifying

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data and said digital images from which the order may be placed (see at least Abstract and Col 8, lines 23 – 25). Moreover:

regarding claim 16, Garfinkle teaches a method wherein said high resolution image comprises a digital image (Col 8, line14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of McIntyre and Enomoto with the method of Garfinkle to have enabled a method of transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted; and said third party placing an order for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed – in order to allow additional orders from parties other than the photographer. With these features, the customer is able to share photos with others as well as allow them to order these too – if desired. In this manner, the photographer's satisfaction will be increased with these features of sharing with others as well as allowing them to order and thereby increasing the probability that the photographer and others will use these provided services in the future. Furthermore, these features will also increase the amount of potential revenue for the service provider.

**Claims 2 – 5 and 10 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McIntyre, Enomoto and Garfinkle as applied to claims 1 and 9 above, and further in view of Sheridan (US 5,760,917).**

The combination of McIntyre, Enomoto and Garfinkle substantially disclose and teach the applicant's invention.

However, the combination of McIntyre, Enomoto and Garfinkle does not specifically disclose and teach a method wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images; and wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image; and wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded – as well as wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received.

Regarding claim 2 and related claim 10, Sheridan teaches a method wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images (Col 2, lines 58 – 67).



Regarding claim 3 and related claim 11, Sheridan teaches a method wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image (see at least Abstract) and regarding claim 4 and related claim 12, Sheridan teaches a method wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded (Col 2, lines 28 – 30).

Regarding claim 5 and related claim 13 wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received. Please note, Sheridan does not specifically teach regarding "order confirmation", this capability of order confirmation for online shoppers – regardless of the party involved in the ordering is old and well known to one of ordinary skill in the art. Moreover, this statement regarding old and well known was contained in the previous Final Rejection. As result, if the applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following is admitted prior art: wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of McIntyre, Enomoto and Garfinkle with the method of Sheridan to enable providing wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images; and wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image; and wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded as well as wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received – in order to have provided the capability for the service provided to ease the online shopping process for all parties. In that regard and with these added features, the online party's satisfaction will be increased and thereby increasing the probability that they will return in the future for their film developing needs as well as recommending the site to others.

**Claims 6 - 7 and 14 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McIntyre, Enomoto and Garfinkle as applied to claims 1 and 9 above, and further in view of Fredlund (US 5,666,215).**

The combination of McIntyre, Enomoto and Garfinkle substantially disclose and teach the applicant's invention.

However, the combination of McIntyre, Enomoto and Garfinkle does not specifically disclose and teach wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party and wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images.

Regarding claim 6 and related claim 14, Fredlund teaches a method wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party (Col 2, lines 40 – 44).

Regarding claim 7 and related claim 15, Fredlund teaches a method wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images (Col 2, lines 45 – 56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of McIntyre, Enomoto and Garfinkle with the method of Fredlund to have enable said customer provides a predetermined amount of credit

which may be charged to said customer with respect to ordering of goods and/or services by said third party and wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images – in order to have provided the additionally capabilities for customers to allow others to charge to certain credit limit as well as providing other items to purchase. In that regard, the customer's satisfaction will be enhanced as well potentially increasing the revenue for the service provided by including additional accessories to be purchased with each order and thereby potentially increasing the revenue for the service provider.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 - 15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is DiVencenzo (US 5,965,859), which associates customer data to captured images and "dotphoto, Inc. allows Users to Operate E-Commerce Profit Centers", PR Newswire; New York; Aug 23, 2000 as well as "Snappy Answers; What to do with that shoe box of Photos? The web and Digital Technology Power a Revolution in Photo Processing, Distribution and Display"; Katherine Foran;

Chicago Tribune; Oct 5, 2000, which teaches an e-commerce capability for uploading, sharing low resolution images and providing ordering capability.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

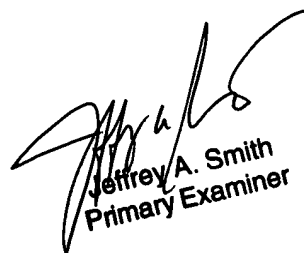
**(703) 746-7418** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER



Jeffrey A. Smith  
Primary Examiner